



## Amendments at Indian National Phase: In Harmony with PCT Standards?

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The Patent Cooperation Treaty (PCT) under Article 28 / Rule 52 or Article 41 / Rule 78 guarantees the applicant the right to amend claims, description and drawings before each designated/elected office, on national phase entry or at least one month thereafter, further to the amendments submitted during the International phase of the application. The Indian Patent Office (IPO) however refuses to allow amendments while entering the national phase,<sup>1</sup> except for deletion<sup>2</sup> of one or more claims under Rule 20(1)<sup>3</sup> of the Patent Rules 2003. The Patent Offices of other PCT signatories like the European Patent Office (EPO), the US Patent and Trademark Office (USPTO), the Intellectual Property Office of Singapore (IPOS)<sup>4</sup>, the Chinese Patent Office (CNIPA) and the Brazilian Patent and Trademark Office (INPI) allow this amendment under Article 28/Article 41 PCT. The IPO accepts all other types of amendments such as merging of two or more claims, alteration of the claim language, etc. only during the national phase proceedings. These amendments can be made either through a request for voluntary amendments in Form 13 along with payment of the associated fee, or in response to the examination report. The latter requires, the applicant to wait until the examination report is communicated. In this article, we are attempting to analyze whether India is in line with the above mentioned provisions of PCT in respect of providing the applicants an opportunity to amend the claims further from that on file in the international phase, at the time of filing the national phase application.

**Keywords:** PCT, Article 28, Article 41, Claim Amendments, Indian National Phase Application, Patent Office Manual, Voluntary Amendment

### Consequences of Restricted Amendments While Entering National Phase

Applicants who enter the Indian national phase under PCT may require their claims to be in tandem with those claimed in other jurisdictions for the ease of prosecution and subsequent enforcement after grant. The provisions of national law allow deletion of claims such as use claims while entering national phase, which in turn saves fees on excess claims. However, many other required amendments, such as merging of two or more claims have to be done voluntarily, after filing the application, by paying additional fees which may be burdensome. Also, a careful examination of dependent and independent claims is necessary while deleting a claim, as any addition or merging done in a later stage may be violative of Section 59(1) of The Patents Act, 1970. Further, amendments done at the entry of the national phase in light of newly available prior art, pending objections in the IPRP or specific requirement of national laws would reduce the objections during the national phase, thereby easing patent prosecution

process and saving time for both the IPO and the applicant.

Alternatively, only those claims that are in reply to the examination report can be amended thereof after it. Also, as per Rule 22 of the Patent Rules 2003, an international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of Rule 20. In the context of voluntary amendments, this means that, if the applicant ventures to amend any part of the application while entering the national phase, except to delete a claim, the application so filed shall be deemed to be withdrawn by the IPO.

### Amendment of Patent Applications in the International Phase

The PCT procedure for processing an application involves two stages of review in the International phase. As per Chapter I of the PCT, all the applications made thereunder is subjected to an initial review performed by the chosen patent office known as the ISA.<sup>5</sup> This initial review which is referred to as 'International Search' will result in the issuance of a summary document called 'International Search

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Report' (ISR) and a Written Opinion (WO). The main purpose of the international search is to discover relevant prior art and obtain a preliminary opinion. Once the applicant receives the International Search Report and the Written Opinion from the ISA, there is one opportunity provided to amend claims under Article 19 PCT.

**Article 19(1):** *“The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.”*

The submission for claim amendments under Article 19(1) is made directly to the International Bureau and not to the Receiving Office or ISA. They essentially contain sheets containing replaced claims, a letter stating the difference between the claims as filed and the claims as amended with the details of basis of the amendment mentioned and an optional statement regarding the claims to the International Bureau which must not exceed 500 words if in English or when translated into English.<sup>6</sup> The prescribed time limit for such amendments is 16 months from the priority date or two months after the transmittal (that is, the date of mailing) of that report and opinion, whichever expires later. Amendments received by the International Bureau after the expiry of the time limit are also accepted if they are received before the technical preparations for international publication are completed.<sup>7</sup>

However, if an applicant wishes to amend the application in light of the contents of the search report and written opinion and to have a second patentability assessment carried out on the amended application, they can file a demand for International Preliminary Examination with a National or Regional Patent Office that has been appointed as an International Preliminary Examining Authority (IPEA) under the PCT. The IPEA<sup>8</sup> sends a written opinion that contains preliminary and non-binding findings which sets out the IPEA's assessment of the novelty, inventive step and industrial applicability of the invention as claimed. Further, to the opportunity to amend the claims under Article 19, the applicants are entitled to amend claims, description and the drawings

under Article 34 on demand of Chapter II examination.

**Article 34(2)(b):** *“The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.”*

Article 34(2)(b) confers the applicant the right to amend the claims, the description and the drawings during the examination, if time permits, until the preparation of the international preliminary report on patentability (IPRP under Chapter II of the PCT). The statement for demand must indicate if the applicant who had made prior amendment of claims under Article 19 wishes to retain the amendment (in that case a copy of the amendments should be filed with the Demand) or to be reversed under Article 34. If no amendments under Article 19 have been made but the time limit for filing such amendments has not expired at the time when the demand is filed, the statement should indicate that the applicant wishes to postpone the start of the international preliminary examination. If any amendments under Article 34 are submitted with the demand, the statement must so indicate. Further, the applicant may choose to file amendments under Article 34 at a later stage which supersede amendments previously made under Article 19, even though the statement of demand indicates that those previous amendments should be taken into account. Thus, the information contained in the statement is used by the IPEA to determine when, and on what basis, the International Preliminary Examination is to start.<sup>9</sup> Under Chapter 2, the IPEA finally issues an IPRP which contains the amended claims (if any were made under Chapter 2) at the end of the International Examination procedure.

### **National Phase Amendments under PCT**

Although an applicant is already provided an opportunity to amend the claims in the international phase under Article 19 and Article 34, they can still make amendments, which may be different for the purposes of the various designated Offices, in the national phase. As per Article 28/ Rule 52 or Article 41/ Rule 78 PCT, all designated and elected Offices are obliged to permit such amendments for at least one month from the time when the applicant enters the national phase.

### Relevant PCT Provisions

**Article 28:** *“The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each designated Office within the prescribed time limit. No elected Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired, except with the express consent of the applicant.”*(Article 41 similarly worded).

**Rule 52.1(b), PCT Regulations:** *“ In any designated State in which the national law provides that examination starts only on special request, the time limit within or the time at which the applicant may exercise the right under Article 28 shall be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under Rule 52.1(a).”*

Under **Rule 52.1(a)**, the time limit to exercise the right under Article 28 is *“within one month from the fulfillment of the requirements under Article 22...”*

**(Rule 78.1(b) and Rule 52.1 (b)** are similarly worded).

**Article 22:** *“The applicant shall furnish a copy of the international application and a translation thereof and pay the national fee, to each designated Office not later than at the expiration of 30/31 months from the priority date.”*

The time limit to enter the national phase is normally 30 or 31 months from the priority date. In India, it is 31 months as per Rule 20[(4)(i)]. As per Rule 52.1(b) or Rule 78.1(b) PCT, the prescribed time limit to make voluntary amendments in the national phase application starts ‘from’ the date of entry into the national phase and ends on the expiry of one month from the date of national phase entry. However, the countries where examinations start only on special requests are free to give additional time for filing voluntary amendments, but it shall not, at any event, be less than the aforesaid one month, as per Rule 52.1(b)/ Rule 78.1(b) PCT. Therefore, for such countries, the deadline for filing the amendments is on the last date on which the request for examination may be filed. In India the request for examination shall be filed within 48 months from the date of priority of the application or the date of filing of the application, whichever is earlier.<sup>10</sup> The use of the term ‘time limit within’ in Rule 52.1 (b) suggests that the

above time limit is inclusive of the date of filing the national phase application. In other words, as per the PCT provisions, request for voluntary amendment may be made along with the filing of national phase application at the time of entering this phase. However this flexibility allowed by PCT is not operationalized by the Indian Patent Office. Amendments ‘at the time of national phase entry’ is not being permitted in the Indian National Chapter of PCT Applicant Guide,<sup>11</sup> as will be discussed in the next section below.

European patent system demonstrates a model of strict adherence to PCT Article 28/ Rule 52 or Article 41/ Rule 78. It allows voluntary amendment of the Euro-PCT patent applications in Form 1200,<sup>12</sup> at the time of its European regional phase entry, along with the patent application.<sup>13</sup>

Before the US Patent Office, according to 35 U.S.C. 371, the applicant may present amendments to the specification, claims, and drawings of the application after the national stage has commenced, within the time limit prescribed under Article 28 or Article 41.<sup>14</sup> Clearly, in this provision, there is room for the interpretation that amendments are also allowed at the time of filing the national phase application. Therefore, in practise, the Applicants are allowed to submit what is called a Preliminary Amendment<sup>15</sup> in which they can amend claims as needed or add new claims, upon entry to the US, along with the national phase application. Amendments to the specification, (other than the claims,<sup>16</sup> computer listings and sequence listings), are to be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification.<sup>17</sup>

### Voluntary Amendments during Indian National Phase Entry

The relevant provisions of the Patents Act 1970, Patent Rules 2003 & Patent Office Manual 2019 are extracted herein below:

#### The Patents Act, 1970

**Section 138(4):** *“An international application filed under the Patent Cooperation Treaty designating India shall have effect of filing an application for patent under Section 7, Section 54 and Section 135, as the case may be, and the title, description, claim and abstract and drawings, if any, filed in the international application shall be taken as complete specification for the purposes of this Act.”*

**Section 138(6):** “Amendment, if any, proposed by the applicant for an international application designating India or designating and electing India before international searching authority or preliminary examination authority shall, if the applicant so desires, be taken as an amendment made before the patent office.”

### Patent Rules, 2003

**Rule 20(1):** “An application corresponding to an international application filed under Patent Cooperation Treaty may be made in Form 1 under sub-Section (1A) of Section 7. Explanation- For the purpose of this Rule, “an application corresponding to an international application means an international application as filed under Patent Cooperation Treaty which includes any amendments made by the applicant under Article 19 and communicated to Designated Office under Article 20 or any amendment made under sub-clause (b) of clause (2) of Article 34 of the Treaty.

*Provided that the applicant, while filing such application corresponding to an international application designating India, may delete a claim, in accordance with the provisions contained in Rule 14.”*

**Rule 23:** “(1) The provisions of this Chapter IV shall be supplemental to the PCT and the regulation and the administrative instructions made there under. (2) In case of a conflict between any provisions of the rules contained in this Chapter and provisions of the Treaty and the regulations and the administrative instructions made there under, the provisions of the Treaty and the regulations and administrative instructions made there under shall apply in relation to international applications.”

### Patent Office Manual 2019

**Rule 07.03.02.5:** “The applicant may make a request to the Controller for amendment of the complete specification which was filed with the national phase application, as a separate request in Form-13, along with the application.”

**Rule 07.03.02.7:** “...at the time of filing the national phase application corresponding to international application designating India, the applicant may delete a claim as provided in Rule 20 (1), in accordance with the provisions contained in Rule 14, without filing an application for amendment. It is clarified that only deletion of claims is allowable

*and no other amendment, such as addition, revision or modification of claims, is allowable.”*

Section 138 (4) and Section 138 (6) of the Patents Act when read with Rule 20(1) of Patent Rules could lead to an interpretation that the amendments to applications ‘while entering the national phase’ are not allowed. However, on a closer look, it may be found that the above sections are worded in such a way that it does not give out a negative connotation with respect to admissibility of voluntary amendments ‘at the time of national phase entry’. In other words the sections focus on what are allowed or acceptable by the Patent office in connection with national phase applications rather than what are not allowed/ forbidden. The provisions are open ended and thus subjectable to more than one interpretation. As per Rule 23 of the Patent Rules, the PCT and the Regulation take precedence over what is stipulated in Rule 20 (1). For the said reason and also on applying the doctrine of harmonious construction, the most appropriate interpretation would be the one in line with the corresponding provisions in PCT- Article 28/ Rule 52 or Article 41/ Rule 78 which permits voluntary amendments at the time of national phase entry. For example, in China,<sup>18</sup> the State Intellectual Property Office (SIPO) allows all types of voluntary amendments at the time the international application enters the national phase by virtue of Article 28 and Article 41 PCT. It also facilitates voluntary amendment of international application for a patent for utility model within two months from the date of national phase entry.<sup>19</sup> Similarly in Brazil,<sup>20</sup> a patent application may be modified until the end of the examination procedures (including appeals). However, the specific amendments that can be done are regulated by the time the request for examination is filed. These examples show that several national offices have adopted an interpretation of the treaty which permits amendments at the time of national phase entry. Nevertheless, the practice of the Indian Patent Office is to not accept any changes to the application other than deletion of claim(s) at the time of national phase entry.<sup>21</sup> However, Rule 20(1) which allows the applicants to delete claim(s) at the time of filing is also accorded a narrow interpretation by the IPO to limit the scope of voluntary amendments to just deletions and nothing else.

Before the 2016 amendment to the Patent Rules 2003, the applicants of PCT applications who intent to reduce the number of claims while entering Indian

National Phase, had to first file the application as it was filed in the International Phase with excess claim fees and then submit amendment application to delete the claims in national phase.<sup>22</sup> Thus, the patent office was receiving extra fee from applicants in respect of those claims which could be deleted on national entry phase.<sup>23</sup> To resolve this issue, an explanation and proviso were added to Rule 20(1) vide the Patent (Amendment) Rules 2016 allowing the deletion of claims at the time of filing the national phase application.

However, the word 'include' in the Explanation to Rule 20 (1) is of great significance. This points out that it is an inclusive explanation and not limiting to amendments at the International phase under Article 19/Article 34 (2)(b). Therefore, the most natural and logical interpretation of the above explanation would be that Rule 20(1) envisages amendments at the international phase as well as amendments at the time of national phase entry under Article 28/Article 41 of PCT and brings both of them within the ambit of 'an application corresponding to an international application filed under the Patent Cooperation Treaty'. To put it simply, amendments filed at the time of national phase entry under Article 28/Article 41 may also be made in Form 1 under Section 7(1A) of the Patents Act 1970, and need not be made by use of Form 13. However, in our opinion, the IPO is misinterpreting the said Explanation under Rule 20(1) by providing in the Manual that such amendments have to be filed 'as a separate request in Form-13' instead of Form 1. Column 13(b) of the Form 1<sup>24</sup> in its current version only has the provision to accept 'Complete specification as amended before the IPEA' as attachment with the patent application. Therefore, it is time IPO amends the Form 1 in accordance with Rule 20(1), so as to also accept amendments to applications at the time of entering national phase under Article 28/Article 41.

Further, it can be seen that the proviso to Rule 20(1) permits deletion of claims in express terms. However, for this limited reason, the rule may not be interpreted by the IPO to mean that it forbids other kinds of amendments. A positive interpretation of Rule 20(1) read with Rule 23 conveys that the Patent Rules 2003 allows all those amendments permitted under Article 28 / Rule 52 PCT or Article 41 / Rule 78 PCT, at the time of national phase entry.

### **Patent Office Manual and PCT Applicant's Guide: Degree of Relevance & Applicability**

Patent Office Manual and the Applicant's Guide, being executive guidelines have no force and effect of law. They can be revised from time to time by the IPO based on interpretations by courts of law, statutory amendments and valuable inputs from the stakeholders. They are only codifications of the patent procedures to provide internal guidance for prosecution of patent applications at Patent Office. Therefore, any provision in the Manual or the PCT Applicant's Guide inconsistent with/exceeding the dictates of statutory provision require to be amended by the IPO. For the matter at hand, to the extent the Manual 2019 (i) reduces the scope of amendments at the time of national phase entry to just deletions and (ii) prohibits the filing of amendments in Form-1,<sup>25</sup> it exceeds the dictates of Rule 20(1) and therefore Rule 20(1) prevails. At the same time, to the extent it allows filing of amendments along with the Application, it is consistent with Rule 20(1) and Rule 23 and enforceable. Similarly to the extent the Applicant's Guide<sup>26</sup> prohibits filing of amendments along with the application at the time of national phase entry, it is in conflict with the relevant provisions of the Patents Act, Patent Rules and PCT and hence the latter prevails over the former.

To conclude, an appropriate statutory interpretation of Section 138(4), 138(6) and Rule 21 read with Rule 23 enlarges the scope of amendments at the time of national phase entry, so as to include amendments in the form of replacements, additions, corrections, explanations, disclaimer, revision and modifications, not just to claims but also to description and drawings. The same may be implemented in practice, provided IPO is willing to embrace the correct interpretation of Section 138(4), 138(6), Rule 23 and Article 28 / Rule 52 PCT or Article 41/ Rule 78 PCT and revise the Patent Office Manual and the Applicant's Guide accordingly.

### **Fee for Filing Voluntary Amendments during Indian National Phase in Form 13**

If the IPO continues to allow only the post-national phase entry amendments, as a consequence of their narrow interpretation of the above discussed statutory and PCT provisions, the applicants are left with no

Table 1 — The First Schedule Fees of Form 13<sup>27</sup>

Application for amendment of patent application, complete specification or other related documents	Natural person(s) and/or startup	Electronic filing		Physical (paper) filing		
		Small entity 2, alone or with natural person(s) and/or startup	Others, alone or with natural person(s) and/or startup and/or small entity	Natural person(s) and/or startup	Small entity 2, alone or with natural person(s) and/or startup	Others, alone or with natural person(s) and/or startup and/or small entity
Before grant (Rs)	800	2000	4000	880	2200	4400

other option but to file for amendments separately in Form-13 (Table 1).

For applications in Form 1, IPO charges fee only for the additional priority claims, additional claims, sheets in excess of 30, sequence listing of nucleotides and/or amino acid sequences.

### Conclusion

The IPO seems to be following a narrow approach in regard to voluntary amendments while entering the national phase, as a result of an apparent misinterpretation of the PCT, Patents Act and the Patent Rules. Consequently, the Indian applicants are at a disadvantaged position compared to their counterparts in many other jurisdictions, when it comes to procedural simplicity in obtaining patents in India. An applicant friendly approach by IPO towards the implementation of the PCT flexibilities on national phase amendments could incentivize further PCT applications in India. This might pave the way for a level playing field for Indian Applicants and attract prospective foreign investors to India in the long run. The looming threat of applicant migration to foreign jurisdictions like China and Brazil having similar markets for a given invention and better placed at implementing all the PCT mandates, could also be done away with. It is therefore advisable that the IPO revises the Patent Office Manual as well as the PCT Applicant's Guide in adherence to the relevant provisions of the PCT, the Patents Act 1970 and Patent Rules 2003 and permits (i) voluntary amendments through Form 1, along with the filing of national phase patent application (ii) amendments of the claims, description and drawing in the form of replacements, additions, corrections, explanations, disclaimer, revision and modifications at the time of national phase entry.

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